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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,999	12/14/2001	John R. Klug	5814.05	4368

20686 7590 10/01/2004

DORSEY & WHITNEY, LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
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DENVER, CO 80202-5647

EXAMINER

CHOULES, JACK M

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/021,999

Applicant(s)

KLUG, JOHN R.

Examiner

Jack M Choules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7 IDS's 11 pages.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-31 are presented for examination.

#### *Information Disclosure Statement*

2. The information disclosure statements (IDS's) received by the office on (1) 14 December 2001, (2) 10 October 2002, (3) 4 April 2003, (4) 6 August 2003, (5) 24 October 2003, (6) 11 May 2004, and (7) 27 August 2004 in this application prior to the first action a present in the IFW of the application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, these information disclosure statements have been considered by the examiner. An initialed Copy should be attached to this action.

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-35 of U.S. Patent No. 6,411,965 B2. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because claims 1-23 and 30-31 are broader than claims in the patent and thus subsume the claims of the patent. Claims 25-29 refer to constructs and connections in a digital network that were common in the art.

5. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-20 of U.S. Patent No. 5,799,320. Although the conflicting claims are not identical, they are not patentably distinct from each other because personal computers comprise a processor and ports especially when interconnected as in claim 1 of the patent. Thus here also the claims of the application are broader than those of the patent and thus subsume the claims of the patent.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 22 recites the limitation "the interconnecting means" in line 1. There is insufficient antecedent basis for this limitation in the claim. The lack of antecedent basis results

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as the claim depends on claim 1, by changing the dependency for example to claim 19 the antecedent basis of claim 22 would be satisfied.

9. Claims 23-29 are dependent on claim 22 and thus incorporate the same lack of antecedent basis.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 6-16, 19, 22-24, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarin et al in “Computer-based Real Time Conferencing Systems” as part of a text by edited by Grief in Computer-supported Cooperative Work: A Book of Readings. Note: the text and article were provided by applicant as part of an information disclosure statement.

12. As to claims 1, 12 and 13, Sarin teaches a data processing system comprising: “a processor” (page 410, first full paragraph), “a plurality of ports” (page 411, figure 15.3(a) and 15.3 (b)), and “receiving an input...” (page 410, second full paragraph through page 412 last full

paragraph) the fact real-time is specified shows that updates to displays are received

“substantially contemporaneously with the execution of the edits.”

13. As to claims 1, 12 and 13, Sarin also describes two systems that were in public use in 1982 and 1984 during demonstrations at conferences (see page 398 last full paragraph) a data processing system comprising: “a processor” the one of the personal computers, “a plurality of ports” between personal computer processor its monitor and other personal computer along telephone lines, and “receiving an input...” editing the same design drawing with cursers visible to both users of allowing either user to edit a document, the fact real-time is specified shows that updates to displays are received “substantially contemporaneously with the execution of the edits.”

14. As to claims 2, 7 and 14, Sarin teaches a system further comprising: “ a host computer” (page 410, first full paragraph) and “multi-task” (page 410, first full paragraph) a processor capable or being time-shared is capable of being multitasked.

15. As to claims 3, 8, and 19, Sarin teaches a “communication network” (page 410, first full paragraph and page 416-417).

16. As to claims 6 and 22-24, Sarin teaches “digital networks” (page 417, third full paragraph).

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17. As to claims 9-11, 30, and 30, Sarin further teaches "graphics" and "text" (page 411, figure 15.3(a)).

18. As to claims 15 and 16, Sarin teaches a system where it would be inherent that some portion of the application program and data be "obtained from data storage" as a workstation must have a copy of the commands it is executing and the data it is operating on to operate (page 410, first full paragraph).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 4-5, 17, 18, 20-21 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Sarin et al as applied to claim 1-2, 13, 19 and 22-24 above.

21. As to claims 4-5 and 20-21, Sarin et al. does not directly detail "analog networks" or "modems". However Sarin describes a previous system which included telephone links between two PC's and it is implicit that these phone lines are used through modems (see page 398 last full paragraph) further he suggests that under some situations it would be advantageous to implement systems such as he describes on personal computers communicating over a telephone line (page 418 third full paragraph). It would have been obvious to one of ordinary skill in the data



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processing art at the time of the applicant's invention to use analog networks and modems in Sarin system because doing so would allow lower cost more easily implemented interfaces to computers that are a location that is remote from the processor and any digital network it might be on system improving the versatility of the DP system.

22. As to claims 17 and 18, Sarin et al. does not detail remote storage or non-persistent. The examiner understands non-persistent to refer to locally non-persistent or available locally only as needed, examiner finds no support in the specification to determine proper interpretation.

Remote memories are well known in the art. Storing the application program remotely could reduce memory usage in the local machine and reduce the number of copies needed for the system as the application would only be present in any particular local system as needed and be non-persistent locally.

23. As to claims 25- 29, Sarin does not detail a hub, switch, bridge, or gateway, but these are all common digital network devices for connecting digital networks or connecting computers to a digital network. It would be obvious to allow one or more of these devices because it would allow flexibility in connecting and adding to a digital network facilitating the addition of more user devices.

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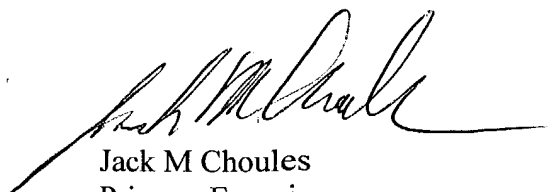
*Conclusion*

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. There is much art that appears to be pertinent to the invention in applicant's disclosures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (703) 305-9840, on 21 October 2004 it will change to (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jack M Choules  
Primary Examiner  
Art Unit 2177

29 September 2004